

REMARKS/ARGUMENTS

The foregoing amendments in the specification and claims are of formal nature, and do not add new matter.

Prior to the present amendment, Claims 28-40 were pending in this application. With this amendment, Claims 36 and 37 have been cancelled without prejudice, and Claims 28-35 have been amended to clarify what Applicants have always regarded as their invention.

Claims 28-35 and 38-40 are pending after entry of the instant amendment. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

The amendments to the specification and claims are fully supported by the specification and claims as originally filed and do not constitute new matter. Amendments to Claims 28-32 can be found in Example 149 at least on pages 511-512 of the specification.

1. Formal Matters

In response to the Examiner's assertion that references 1 and 2 in the Information Disclosure Statement filed on September 20, 2002, are not in proper format, Applicants file herewith, an Information Disclosure Statement listing each reference of the "Blast Search" separately and including authors/inventors, relevant accession numbers and publication dates. Applicants respectfully request that the listed information be considered by the Examiner and be made of record in the above-identified application.

2. Claim Rejections - 35 USC § 112, First Paragraph (Enablement)

Claims 28-32 and 39-40 stand rejected under 35 USC § 112, first paragraph. In particular the Examiner asserts that "the specification, while being enabling for an isolated polypeptide having at least 80% amino acid identity to the polypeptide of SEQ ID NO:194 or the mature form thereof, which isolated polypeptide affects glucose or FFA uptake by primary rat adipocytes, does not reasonably provide enablement for a polypeptide not identical to at least the mature form of SEQ ID NO:194 which does not have this activity." (see instant Office Action, page 2).

Applicants respectfully disagree and traverse the rejection.

While not acquiescing in the propriety of this rejection, and solely in the interest of furthering prosecution, Applicants have amended Claims 28-32 (and, as a consequence, those claims dependent from the same) to recite, "wherein the polypeptide stimulates the uptake of glucose or FFA (free fatty acid) by adipocyte cells." Since the claimed genus is now characterized by a combination of structural and functional features, any person of skill would know how to make and use the invention without undue experimentation based on the general knowledge in the art at the time the invention was made. As the M.P.E.P. states, "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation" *In re Certain Limited-charge cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'. sub nom.*, *Massachusetts Institute of Technology v A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) M.P.E.P. 2164.01. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

3. Claim Rejections - 35 USC § 112, First Paragraph (Written Description)

Claims 28-32 and 39-40 are also rejected under 35 USC 112, first paragraph, for lack of written description. In particular, the Examiner asserts that the claims are directed to polypeptides having at least 80-99% amino acid identity to SEQ ID NO:194 or the extracellular domain thereof, but that they do not require that the polypeptides possess any particular biological activity.

Applicants respectfully disagree and traverse the rejection.

Without acquiescing to the Examiner's position, and solely in the interest of expediting prosecution in this case, Claims 28-32 (and, as a consequence, those claims dependent from the same) are amended to recite a polypeptide that "stimulates the uptake of glucose or FFA (free fatty acid) by adipocyte cells." Accordingly, it is no longer true that the claims are drawn to a genus of polypeptides defined by sequence identity alone. This biological activity, coupled with a well defined, and relatively high degree of sequence identity are believed to sufficiently define the claimed genus, such that one skilled in the art would readily recognize that the Applicants

were in the possession of the invention claimed at the effective filing date of this application. The Examiner is therefore respectfully requested to reconsider and withdraw the present rejection.

4. Claim Rejections – 35 USC § 112, Second Paragraph

Claims 28-40 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner objects to the applicant's use of the terms "extracellular domain" and "lacking its associated signal peptide."

Applicants submit that the cancellation of Claims 36 and 37 and renders the rejection of these claims moot.

Without acquiescing to the Examiner's position, and solely in the interest of expediting prosecution in this case, as amended, the terms "extracellular domain" and "extracellular domain ... lacking its associated signal peptide" are no longer present in Claims 28-33 (and, as a consequence, those claims dependent from the same). Hence, the rejection is believed to be moot, and should be withdrawn.

Conclusion

All claims pending in the present application are believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney's Docket No. 39780-2830 P1C14). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: December 21, 2004

By: _____

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